

REMARKS/ARGUMENTS

Prior to the entry of this Amendment, claims 1-17 were pending in this application. No claims have been amended, no claims have been added and no claims have been canceled herein. Therefore, claims 1-17 remain pending in this application. Applicant respectfully requests reconsideration of this application for at least the reasons presented below.

35 U.S.C. § 103 Rejection, Takano in view of Serbinis and Gross

The Office Action states that claims 1-17 remain rejected for reasons of record, *i.e.*, rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,434,580 of Takano et al. (hereinafter "Takano") in view of U.S. Patent No. 6,584,466 of Serbinis et al. (hereinafter "Serbinis") and further in view of U.S. Patent No. 6,918,082 of Gross et al. (hereinafter "Gross"). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). However, the references cited by the Office Action do not teach or suggest each claimed limitation. For example, none of the references, alone or in combination, teach or suggest a workflow rule or executing the workflow rule to generate a message requesting approval to prepare a patent application from an invention disclosure.

Takano relates to "preparing data for patent application documents by the transmission and reception of draft data via a server computer between a client computer used by an inventor preparing the draft data for a specification to be included in his or her patent application and another client computer used by patent-application-filing persons including a patent attorney revising the draft data." (Col. 2, lines 1-9) That is, Takano discloses methods and systems for use by an inventor and "patent-application-filing person" to collaborate on a draft patent application. Under Takano, an inventor enters information for the draft specification of the patent application. (Col. 6, lines 43-59) The inventor also enters "invention report information" such as a title, his name, telephone number, email address, etc. (Col. 7, lines 13-26) The draft and invention report information are then uploaded and saved on a server. (Col. 7, lines 27-50) Once the draft is available on the server, the patent-application-filing person, *i.e.*, attorney or agent, can download (col. 8, lines 7-24), edit (col. 8, lines 33-37), and upload and save (col. 8, lines 38-67). The inventor can download and check the edited draft. (Col. 9, lines 54-65) Takano discloses a "notification means" for sending an email to the patent-application-filing person or inventor but does not disclose how this email is addressed. Presumably, the email is addressed based on an address entered in the invention report information. However, as indicated in the Office Action, Takano does not teach or suggest a workflow rule.

Serbinis "relates to apparatus and methods for managing electronic documents over open networks, such as the Internet, to permit users to store, retrieve, and collaboratively manipulate files." (Col. 1, lines 7-10) Serbinis discloses "an Internet-based document management system and methods wherein an electronic document may be stored on an Internet-accessible server and accessed using a previously known web browser, downloaded for review or manipulation, and then returned to the server for access by further users." (Col. 3, 14-19) Serbinis's document management system is programmed to provide a plurality of services including "storage and retrieval services to and from an Internet-based storage site, an electronic document delivery service, a collaborative file sharing service and a workflow service, and a document distribution service." (Col. 3, lines 24-30) Under Serbinis, "a workflow table may be

associated with a document in DMS database that specifies multiple tasks to be performed in sequence by the Authorized Users." However, Serbinis does not teach or suggest a workflow rule, only a table or list of tasks.

The Office Action argues that Serbinis does in fact disclose a workflow rule. However, the Applicant respectfully disagrees with this reading of Serbinis and contends that Serbinis does not teach or suggest a workflow rule as recited in the claims and disclosed in the detailed description. For example, a more thorough reading of the detailed description makes clear that the workflow rule recited in the claims is more than a mere list of tasks to be performed in sequence without exception. Rather, the workflow rule provides for conditional performance of some action. For example, see paragraph 82 of the detailed description illustrating a case where, upon approval of an invention disclosure for preparation of an application, the disclosure is assigned to a particular attorney depending upon the group that generated the disclosure. In other words, the workflow rule provides for conditional performance of some action, *i.e.*, if the group is X, assign to attorney X. Serbinis does not teach or suggest such a workflow rule or set of condition and action. Rather, the workflow table of Serbinis simply provides a list of tasks to be performed, from top to bottom, without exception or condition.

Gross "relates to software and systems that allow multiple users to collaboratively proof, annotate, and edit multiple versions of documents over a computer network." (Col. 1, lines 6-8) Gross provides a system for proofing electronic documents delivered over a network where the "system comprises a plurality of electronic documents in portable document file format, a computer connectable to the network for receiving the plurality of portable format documents together with at least one associated proofer identifier, a program executing on the computer for assigning a version number to each of the plurality of received portable format documents, and a database accessible by the computer for storing the documents and associated version numbers." (Col. 3, lines 9-19) "The computer receives requests, from proofers

presenting the proofer identifier, to review a portable format electronic document, and the program retrieves and formats the requested document for display." (Col. 3, lines 19-23) "The computer also receives comments submitted by proofers, in which case the program stores the comments together with the corresponding document version." (Col. 3, lines 27-29) When comments are stored for a document, an email notification can be sent to the document's creator. (Col. 4, lines 55-62) The email is addressed to the creator based on an email address stored in a database entry associated with the document. (Col. 6, lines 1-15) However, Gross does not teach or suggest a workflow rule. Rather, like Takano and Serbinis, Gross teaches a list of tasks to be performed, from top to bottom, without exception or condition.

The combination of Takano, Serbinis, and Gross is no more relevant to the pending claims since none of the references, alone or in combination, teaches or suggests a workflow rule as recited in the claims. Rather, all of the references teach sending email notifications based on a stored record or table of users associated with a document, not based on a rule. That is, none of the references, alone or in combination, teaches or suggests a workflow rule that provides for conditional performance of some action. Instead, the references all teach a list of tasks to be performed, from top to bottom, without exception or condition. For at least these reasons, the combination of references fails to teach or suggest each claimed limitation.

Claim 1, upon which claims 2-12 depend, and claim 13 each recite in part "storing a first workflow rule on a server system . . . and executing said first workflow rule from said server system to generate a message requesting approval of a second client system to prepare a patent application from said first invention disclosure and to communicate said message to said second client system." None of the references, alone or in combination, teaches or suggests storing a workflow rule on a server system and executing the workflow rule to generate a message requesting approval to prepare a patent application. Rather, all of the references teach sending email notifications based on a stored record or table of users associated with a document, not based on a rule. For at least these reasons, claims 1-13 should be allowed.

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PATENT

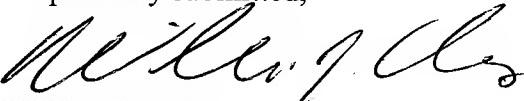
Claim 14, upon which claims 15-17 depend, recites in part "allow[ing] a first client system to set-up workflow rules that define, for predetermined events, selected client systems for said server system to transmit messages to." None of the references, alone or in combination, teaches or suggests a workflow rule. Rather, all of the references teach sending email notifications based on a stored record or table of users associated with a document. For at least these reasons, claims 14-17 should be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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